UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex Parte THOMAS W. KRAUSE

Appeal No. 2006-3368
Application No. 09/759,215

HEARD: December 12, 2006

Before RUGGIERO, BARRY and MACDONALD, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-6 and 8-22, which are all of the claims pending in this application. Claim 7 has been canceled.

The disclosed invention relates to the use of an "age-event" database which contains entries that describe events occurring in the lives of individuals at a certain age. Upon the input of a target individual's age, an output is presented which consists of information from the "age-event" database. More particularly, the "age-event" database can be used to create date-related products such as greeting cards, calendars, etc., which inform the user or recipient of

accomplishments of famous individuals, or individuals known to the user or recipient, when they were the user or recipient's age.

Claim 1 is illustrative of the invention and reads as follows:

> 1. A computer-implemented method for providing a user with age-event information comprising:
>
> a) receiving an input signal;
>
> b) determining age information from said input signal;
>
> c) using said age information to search a database for age-event information corresponding to said age information; and
>
> d) providing an output signal comprising age-event information corresponding to said age information;
>
> wherein said age information comprises the age of a first individual on a specific date and said age-event information comprises information regarding an event that occurred in the life of a second individual when said second individual was at an age equal to the age of said first individual on said specific date.

The Examiner relies on the following prior art:

Kendrick	5,031,161	Jul. 09, 1991
Slotznick	5,983,200	Nov. 09, 1999
McDonald et al. (McDonald)	6,069,848	May 30, 2000

New England Technology Group (NETG), "Since You Were Born," Saint Louis Zoological Park, pages 1-14 (manually numbered), April 13, (1988).

Tom Ruane (Ruane), "Half-life," Southern Review (PSRV), vol. 32, No. 1, 1-6 (manually numbered), (1996).

Claims 1-6 and 8-22, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers NETG in view of Ruane with respect to claims 1-6, 14, 15, 18, 21, and 22, adds McDonald to the basic combination with respect to claims 8, 12, 16, and 19, and adds Kendrick to the basic combination with respect to claim 13. In addition, claims 9-11, 17, and 20 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of NETG, Ruane, McDonald, and Slotznick.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as recited in claims 1-6 and 8-22. Accordingly, we affirm.

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined

on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed waived [see 37 CFR § 41.37(c)(1)(vii)].

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 1, 14, and 18 based on the combination of NETG and Ruane, after reviewing the Examiner's analysis (Answer, pages 3-5), it is our opinion that the stated position is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of obviousness. The burden is, therefore, upon Appellant to come forward with evidence and/or arguments which persuasively rebut the Examiner's prima facie case. Appellant's arguments in response to the Examiner's 35 U.S.C. § 103(a) rejection assert a failure to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. After careful review of the disclosures of NTEG and Ruane in light of the arguments of record, however, we are in general agreement with the Examiner's position as stated in the Answer.

Initially, Appellant contends (Brief, page 12; Reply Brief, page 4) that, contrary to the Examiner's position, NETG does not disclose the determination of age information

from an input signal in which the age information is the age of an individual on a specific date as claimed. We do not find this persuasive. As pointed out by the Examiner (Answer, page 13), the system of NETG, after entry of an input information indicative of a birth date, determines the age of an individual in days, i.e., the age of an individual on a specific date as claimed.

With respect to the claimed limitations directed to the searching and providing an output directed to age-event information which corresponds to the input age information, Appellant contends (Brief, pages 12-14; Reply brief, pages 4 and 5) that NETG does not provide age-event information as defined in the claims, i.e., an event which occurs in the life of a second individual when the second individual was at an age equal to the age of the first individual on a second date. While we don't necessarily disagree with Appellant on this point, we do agree with the Examiner (Answer, page 14) that Ruane makes up for any such deficiency of NETG by suggesting the use of exactly such age-event information at page 5, paragraph 6. It is noteworthy that Appellant agrees (Brief, page 14) that Ruane provides a description of age-event information as defined in the "wherein" clauses of independent claims 1, 14, and 18. While Appellant contends that any such age-event information described in Ruane is not related to the "age information" in the claim, we fail to see how Ruane's described age-event information would relate to anything other than the age of an individual on a specific date as defined in Appellant's claims.

We also do not agree with Appellant's further argument attacking the Examiner's use of the Ruane reference in which Appellant contends (Brief, pages 14 and 23; Reply

Brief, page 5) that, although Ruane describes age-event information, there is no disclosure of how a computer program that provides age-event information should be implemented. While we do not necessarily agree with Appellant that the disclosure of Ruane is non-enabling, it is well settled that a non-enabling reference may qualify as prior art for the purpose of a U.S.C. § 103(a) rejection. See Symbol Techs. Inc. v. Opticon Inc., 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991).

We further find to be without merit Appellant's assertion (Brief, pages 20-22; Reply Brief, pages 8 and 9) that proper motivation for the proposed combination of NETG and Ruane has not been established by the Examiner. We find no error in the Examiner's statement of the rationale for combining NETG and Ruane for all of the reasons articulated by the Examiner at pages 5, 15 and 16 of the Answer. We particularly find unpersuasive Appellant's contention that Ruane is non-analogous art with respect to the NETG reference. According to Appellant (Brief, pages 18 and 19; Reply Brief, pages 5-7), while NETG may arguably be considered to be in the data processing art, Ruane is merely a work of fiction appearing in a literary journal. We find no basis, however, to support Appellant's conclusion that the teachings and suggestions contained in the Ruane article are to be dismissed because they appear in a work of fiction, Indeed, we would point out that Appellant's own specification (page 2, line 23) discloses the use of fictional characters as part of the age-event database. Further, although Ruane is a work of fiction, the ideas and teachings expressed therein include a suggestion of computer implementation at page 5, paragraph 7.

For the above reasons, since it is our opinion that the Examiner's prima facie case of obviousness has not been overcome by any convincing arguments from Appellant, the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 1, 14, and 18, as well as dependent claims 3, 5, 6, 8-10, 16, 17, 19, and 20 not separately argued by Appellant, is sustained.

We also sustain the Examiner's obviousness rejection, based on the combination of NETG and Ruane, of separately argued dependent claims 2, 4, 15, 21, and 22. With respect to the "celebrity ageliner" feature of dependent claims 2 and 15, we note that these claims differ from previously discussed independent claims 1, 14, and 18 in that an individual whose age on a specific date is related to an event that occurred in the life of a second individual when that second individual was the same age as the first individual on the specific date is described in the claims as being a "celebrity." We find no error in the Examiner's interpretation of the language of claims 2 and 15 as corresponding to that disclosed in Ruane for the reasons discussed by the Examiner at page 18 of the Answer. We also find that, even in the alternative interpretation offered by Appellant (Brief, pages 24 and 25; Reply Brief, pages 10 and 11), that the description by Ruane corresponds to that claimed. In this interpretation of Ruane, the individual's life in which an historical event occurred is "Jack Kerouac" and the "celebrity" individual, whose age on a specific date is related to the historical event, is the narrator/protagonist character in the Ruane short story. In our view, the term "celebrity" is a relative term in the sense that, as a matter of perception, a person that might be considered a "celebrity" to one segment of the public may not be to another

segment. In any case, we fail to see why a character in a published work of fiction would not be considered a "celebrity," at least in the manner broadly claimed by Appellant.

The Examiner's 35 U.S.C. § 103(a) rejection of separately argued dependent claim 4 is also sustained since, as reiterated by the Examiner (Answer, page 14), the rejection is based on the combination of NETG and Ruane. With this in mind, it is apparent to us that, in Ruane, the suggested output includes the age of the first individual, i.e., the individual whose age is related to an historical figure, on a specific date. Similarly, we also sustain the Examiner's obviousness rejection of dependent claims 21 and 22 since, in our view and Appellant's arguments to the contrary notwithstanding, in order for age-event information of a second individual to be related to the age of a first individual on a specific date as an system output as suggested by Ruane, the name of the second individual must be entered as a system input.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of dependent claims 8, 12, 16, and 19, based on the combination of NETG, Ruane, and McDonald, we sustain this rejection as well. To whatever extent Appellant is suggesting (Brief, pages 27-30; Reply Brief, page 13) that the Examiner's proposed addition of McDonald to the combination of NETG and Ruane must fail since, in Appellant's view, McDonald does not provide a disclosure of age-event information, we find such contention to be without merit since the Examiner has relied upon Ruane for this teaching. It is apparent from the Examiner's line of reasoning in the Answer that the basis for the obviousness rejection is the combination of NTEG, Ruane, and McDonald.

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F. 2d 413, 425, 208 USPQ 871, 881(CCPA 1981); In re Merck & Co., Inc., 800 F. 2d 1091, 1096, 231 USPQ 375, 380 (Fed. Cir. 1986).

With the above discussion in mind, it is our view as also alluded to by the Examiner (Answer, pages 9 and 10) that, with respect to appealed claims 8, 16, and 19, the customized greeting on a specific date taught by McDonald would serve as an obvious enhancement to the system of NETG as modified by the age-event teachings of Ruane. Further, with the realization that Ruane, and not McDonald, is relied upon by the Examiner as providing age-event information, it is apparent to us, with respect to dependent claim 12, that the illustration in Figure 12 of McDonald shows information for at least two dates in the life of an individual, i.e., the birth date and the elapsed time from the birth date to the present date.

With respect to dependent claim 13 in which Kendrick is added to the combination of NETG and Ruane to address the life-clock display feature, Appellant's argument (Brief, pages 31-33; Reply brief, page s 13 and 14) reiterates the contention made with respect to the previously discussed McDonald reference, i.e., Kendrick lacks a disclosure of age-event information as claimed. We find this argument unpersuasive for the same reason as discussed supra with regard to McDonald, i.e., it is Ruane, not Kendrick that is relied upon for a teaching of age-event information. We find no error in the Examiner's assertion of obviousness to the skilled artisan of adding a life-clock

display to the combination of NTEG and Ruane and, accordingly, the Examiner's obviousness rejection of dependent claim 13 is sustained.

Lastly, we also sustain the Examiner's obviousness rejection of dependent claims 9, 10, 11, 17, and 20 in which the McDonald and Slotznick references are added to the combination of NTEG and Ruane to address, respectively, the electronic greeting card (claims 9 and 10) and customized calendar (claims 11, 17, and 20) features of these claims. Again, we find to be without merit Appellant's argument (Brief, pages 33-36; Reply Brief, page 14) that the secondary references to McDonald and Slotznick do not disclose the use of age-event information since it is Ruane that is relied upon for this teaching. We agree with the Examiner, for the reasons articulated in the Answer (pages 11 and 12) that the ordinarily skilled artisan would have recognized and appreciated that the electronic greeting card and customized calendar features taught by Slotznick would have served as an obvious enhancement to the combination of NETG and Ruane as modified by McDonald.

In summary, we have sustained the Examiner's 35 U.S.C. § 103(a) rejection of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-6 and 8-22 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective September 13, 2004).

AFFIRMED

JOSEPH F. RUGGIERO)
Administrative Patent Judge)
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